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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,773	09/27/2000	Clark Pan	MSB-7272	7437

7590 02/03/2003
Melissa A Shaw
Patent Department
Bayer Corporation
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EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/671,773

Applicant(s)

PAN ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election of Group 1, claims 1, 6, and 19, and of SEQ ID NO: 72 in Paper No. 8, filed 7/10/02, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

All SEQ ID NO's other than SEQ ID NO: 72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

An action on the merits of pending claims 1, 6, and 19, as they read on elected SEQ ID NO: 72, follows.

Specification

The spacing of the lines of the specification is such that punching of holes to place papers in the case resulted in holes through words on every page of the specification. As pages with missing information will not be printed, the examiner requests that a substitute specification be filed with sufficient space at the top of pages for hole-punching.

Sequence Rules Compliance

Pages 6 and 13 of the specification disclose sequences which are not identified by SEQ ID NO's, on lines 33 and 19, respectively. As set forth in 37 CFR 1.821, every

Art Unit: 1631

amino acid sequence containing more than 4 defined amino acids must appear separately in the "Sequence Listing" and on a CRF, and each sequence set forth in the "Sequence Listing" must be assigned a separate sequence identifier. Applicant is required to comply with the Sequence Rules within the time period set for response to this Office Action. Applicant is advised that any reply filed before the sequence rules are complied with will be considered nonresponsive. Applicant is reminded that changes to the sequence listing and/or CRF must not contain new matter and must be accompanied by a statement confirming that the paper copy of the sequence listing and the CRF are identical. See 37 CFR 1.821 and 37 CFR 1.825.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by BOLIN (US 5,234,907).

BOLIN teaches a variety of proteins (SEQ ID NO's 1-93 of the sequence listing) which are variants of instant SEQ ID NO: 72, Since all of BOLIN's peptides are variants of VIP, as is instant SEQ ID NO: 72, and BOLIN teaches that his peptides have similar function (col. 8, lines 63-68), claims 1 and 16 are anticipated. BOLIN also teaches that

Art Unit: 1631

his peptides may be combined with pharmaceutical carriers (col. 9, lines 1-4), thus anticipating claim 6.

Claims 1, 6, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by SAWAI et al. (US 5,376,637).

SAWAI teaches pharmaceutical compositions comprising peptides (abstract and SEQ ID NO's 1-3, col's 11-14) which are variants of instant SEQ ID NO: 72, Since SAWAI's peptides are variants of VIP, as is instant SEQ ID NO: 72, and SAWAI teaches that his peptides have similar function (col's 7-12, Examples 1-6), claims 1, 6, and 16 are anticipated.

Conclusion

Claims 1, 6, and 19 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9306 for After Final communications.

Art Unit: 1631

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.

MARTIN MORAN
PATENT EXAMINER

Martin A. Moran

January 31, 2003